

**REMARKS**

This is intended as a full and complete response to the Office Action dated November 1, 2004, having a shortened statutory period for response set to expire on February 1, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-26 are pending in the application. Claims 1-26 remain pending following entry of this response. Claim 1 has been amended. Claim 1 has been amended to clarify the claimed embodiments. Applicants submit that claim 1 does not introduce new matter.

**CLAIM REJECTIONS - 35 U.S.C. § 112**

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicants begin by first reviewing the 35 U.S.C. § 112 ¶ 1 enablement requirements. Applicants then proceed to respond to Examiner's enablement arguments.

**35 U.S.C. § 112 ¶ 1 Enablement Requirements**

35 U.S.C. § 112 ¶ 1 states that the specification shall contain the manner and process of making and using the claimed invention, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which the claimed invention pertains to make and use the claimed invention. The test of enablement is whether one reasonably skilled in the art could make or use the claimed invention from the disclosures in the patent coupled with information known in the art without undue experimentation. See MPEP § 2164.01, citing *United States v. Telectronics*, 857 F.2d 778, 785 (Fed. Cir. 1988). However, it is well-settled that the enablement requirement does not require a patent to teach, and preferably omits, what is well known in the art. See *id.*, citing *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991).

Furthermore, as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement is satisfied. See MPEP § 2164.01(b). Failure to disclose other methods by which the claimed invention may be

made does not render a claim invalid for lack of enablement. See *id.* The amount of guidance or direction needed to enable the claimed invention is inversely related to the amount of knowledge in the state of the art as well as the predictability of the art. See MPEP § 2164.03. Finally, Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP § 2164.04. Any conclusion of nonenablement must be based on the evidence as a whole. See MPEP § 2164.01(a) citing *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Specifically, Examiner must consider all of the evidence related to each of the factors presented by *In re Wands*. See *id.*

#### Response to Examiner's Enablement Arguments

Applicants respectfully submit that Examiner has not met the burden required to prove nonenablement. First, Examiner has failed to establish the level of one of ordinary skill in the art. Further, Examiner has failed to discuss the level of predictability in the art. Also, Examiner has failed to discuss the amount of direction provided by the inventor, specifically by failing to discuss the entire relevant teaching contained in the specification. Finally, Examiner has failed to consider information known in the art. Because Examiner has not considered the above factors and all of the evidence relating to the above factors, Applicants respectfully submit that Examiner's rejection is improper and request that the objection be withdrawn.

Examiner also appears to make inconsistent rejections. For instance, Examiner rejects the claims for lack of enablement, but Examiner also rejects the same claims as being obvious in light of the cited prior art. Examiner appears to suggest that a low level of skill in the art is needed to appreciate the present claims (See Paper 10, Pgs. 12-13), and that the present claims are obvious to one of ordinary skill in the art (See Paper 10, Pgs. 5-11). At the same time, by rejecting the claims for lack of enablement, Examiner suggests that the same person of ordinary skill in the art would not comprehend how to practice the claimed invention. Applicants respectfully submit that the two assertions are inconsistent.

The foregoing are general responses applicable to Examiner's rejection of pending claims on the basis of lack of enablement. On this basis alone, Applicants

Page 7

328664\_2

respectfully submit the rejections are improper and request that the rejections be withdrawn. In addition, Applicants submit the following additional specific responses to particular claims.

#### *Rejection of Claim 1*

With respect to claim 1, Examiner states that "the specification does not contain a clear and concise written description of the manner and process" of automatically designating one of at least two frames as a default search frame. See Paper 10, Pg. 3. Examiner also states that based on the disclosure cited by Examiner, the skilled artisan would not be able to make and use the claimed invention because several possible instances of automatically designation are provided without an in-depth process of making a means of automatic designation. See *id.* Examiner goes on to state that the method of automatically selecting a default frame from a plurality of frames and then coordinating the searching process with the selected default frame is not described in the specification. See *id.*

Applicants note that Examiner's statement that "the method of automatically selecting a default frame and then coordinating the searching process with the selected default frame" is incorrect because the pending claims do not describe "default frames" (they describe "default search frames"). A threshold requirement to making a proper rejection is ascertaining the metes and bounds of the claim according to the specific claim language. See MPEP § 2164.04. By disregarding key elements of claim language, Applicants submit that a proper rejection is impossible, and in fact, has not been made in the present instance. Thus, Applicants respectfully submit the rejection is improper for failing to properly construe the claims and request that the rejection be withdrawn.

Examiner has also stated that the specification should provide "an in-depth process of making a means of automatic designation." However, as conceded by the Examiner, the specification does provide several possible instances of how a default search frame may be automatically designated. See Paper 10, Pg. 3. Applicants also respectfully note that the enablement standard does not require any "in-depth"

description of the means of making the claimed invention. Thus, Applicants submit the specification is enabling.

Even though an in-depth description is not required, Applicants have, nevertheless, provided numerous extensive descriptions of various embodiments, and submit that any one description is sufficient to satisfy enablement. For example, Applicants have provided an extensive example of how a tag may be used to designate a default search frame. See Pg. 3-4, Paras. 31-47; Fig. 3. Examiner's sole citation is to Para. 20 of the disclosure. See Paper 10, Pg. 3. Examiner has not analyzed other parts of the specification which describe the designation of the default search frame. For instance, the specification contains the above-mentioned description of how a tag may be used to indicate that a certain frame is a default search frame. See Pg. 3, Para. 31-36; Table I. The specification also contains a description of how the tag is used by a process to flag the default search frame. See Pg. 3, Para. 40; Fig. 3. The steps performed by the process which automatically designate the default search frame are clearly described in a manner that would allow one skilled in the art to perform the invention. See *id.*

Furthermore, while Applicants are only required to provide one method for making and using the claimed invention (See MPEP § 2164.01), Applicants have provided several enabled embodiments describing how the default search frame may be automatically designated. See Pg. 3, Para. 41. Also, with respect to implementing embodiments of the invention, the specification states that one embodiment of the invention may be implemented as a program product for use with a computer system. See Pg. 2, Para. 21. Thus, the provided description in the specification is more than sufficient to enable one of ordinary skill in the art to practice the invention.

In summary, for the reasons given above, Applicants submit that Examiner has not met the burden of establishing enablement. Applicants respectfully request that the rejection be withdrawn.

#### *Rejection of Claims 8 and 16*

With respect to the rejection of claims 8 and 16, examiner states that the specification does not include a clear and concise description of the process of selecting

a frame containing a greater content such that a skilled artisan can make and use the claimed invention. See Paper 10, Pg. 3. Initially, Applicants note that Examiner has misstated the language of the claims, perhaps leading to Examiner's belief that the claims are not enabled. Claims 8 and 16 specifically describe "selecting from the at least two frames a frame containing a greater amount of content," not "containing a greater content" as Examiner has stated.

As stated above, Applicant is entitled to rely on both the teachings of the specification and the knowledge of one of ordinary skill in the art in determining whether the claim is enabled. Thus, with respect to the teachings of the specification, the specification describes that the designation of the default search frame may be made according to the frame having the most searchable content. See Pg. 3, Para. 41. Besides Examiner's conclusory statement (See Paper 10, Pg. 3), Examiner has not provided any analysis as to why the specification is not enabling. *Id.* Indeed, Examiner has failed to discuss any of the *Wands* factors, a discussion mandated by MPEP § 2164.01(a). Thus, by analysis of Examiner's arguments alone, Examiner has failed to meet the burden of establishing a case of nonenablement.

Appellants respectfully submit that the specification is enabling given the knowledge of one of ordinary skill in the art. See MPEP § 2164.03. Accordingly, with respect to selecting a frame with the greater amount of searchable content, the determination of which frame contains the greater amount of searchable content is objectively discernible and well within the level of ordinary skill in the art. Selection of frames is also described in the specification (See Pg. 3, Paras. 36-37, 40-41; Pg. 4 Paras. 42-43) and is well within the level of ordinary skill in the art. Therefore, the specification is sufficient to enable one of ordinary skill in the art to practice the claimed invention. Accordingly, Applicants respectfully request that the rejection be withdrawn.

#### *Rejection of Claims 2-7, 9-15, and 17-26*

Examiner rejects claims 10 and 21 for reasons similar to claim 1. Examiner also rejects claims 2-7, 9, 11-15, 17-20, and 22-26 for each being dependent from a rejected base claim. As explained above, Applicants believe the rejection with respect to claim 1 is improper and accordingly request that the rejection of all of the claims be withdrawn.

35 U.S.C. § 112 ¶ 2 Requirements

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. 35 U.S.C. § 112 ¶ 2 states that the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Response to Examiner's Definiteness Arguments

Examiner objects to claim 1 as being indefinite because, as the Examiner states, the limitations contained in the claims are contradictory. See Paper 10, Pg. 4. Specifically, Examiner states that it is unclear how a second frame can be searched when the first frame is automatically designated as the search frame. *Id.* Examiner states that when the first frame is designated as the default search frame, the second frame is not searchable. Applicants respectfully submit that designating a first frame as the default search frame does not make the second frame unsearchable, and thus, the limitations are not contradictory.

A "default" may be defined as a selection automatically used by a computer program in the absence of a choice made by the user. See Merriam-Webster Online Dictionary, [www.m-w.com](http://www.m-w.com). For example, as well known to computer users, a default computer browser is the browser which is automatically opened when the user requests a web page. A user may have more than one browser on a single computer, but the default browser may be used in absence of a contrary choice by the user. The fact that one browser is the default browser does not render other browsers on the computer inoperable. The user is still free to select and open the other browser, despite the fact that another browser is the default.

Similarly, in the present application, designating a default search frame does not render other frames unsearchable. For instance, as described in the specification, if another frame is selected by the user, that frame may be flagged as the default search frame. See Pg. 4, Para. 43. In another case, the content of the default search frame may be searched (See Fig. 3, Item 324, Pg. 4, Para. 44) but if the search string is not

found (See Fig. 3, Item 326, Pg. 4, Para. 44) the other frames may be subsequently searched (See Fig. 3, Items 330, 332, and 324, Pg. 4, Para. 44). Accordingly, even though one frame is designated as the default search frame, the other frames in a multiple frame environment may remain searchable. Thus, Applicants respectfully submit that designating a first frame as the default search frame does not make the second frame unsearchable, and the limitations are therefore not contradictory nor indefinite. Accordingly, Applicants respectfully submit that the rejection is improper and respectfully request that the objection be withdrawn.

Examiner rejects claims 10 and 21 for reasons similar to claim 1. Examiner also rejects claims 2-7, 9, 11-15, 17-20, and 22-26 for each being dependent from a rejected base claim. As explained above, Applicants believe the rejection with respect to claim 1 is improper and accordingly request that the rejection of the claims be withdrawn on the same grounds.

As a further note, Examiner states that claims 1-26 are rejected as being indefinite, however, Examiner has not provided substantive or specific arguments as to why claims 8 and 16 are rejected as being indefinite. See Paper 10, Pg. 4. Accordingly, Applicants respectfully submit that the rejections of claims 8 and 16 are improper and Applicants respectfully request that the rejections be withdrawn. Furthermore, as understood by Applicants, because claim 8 and 16 have no art rejection, upon overcoming examiners rejection, the claims will be placed in condition for allowance and allowance of the same is respectfully requested.

#### CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 1-4, 6, 7, 10-13, 15, 18-21 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Pat No 6,449,624 issued to *Hammack et al.* (hereafter *Hammack*), in view of US Pat No 6,542,515 issued to *Kumar et al.* (hereafter *Kumar*). Applicants respectfully traverse the rejection. Applicants begin by first reviewing the 35 U.S.C. § 103(a) obviousness requirements. Applicants then proceed to respond to Examiner's obviousness arguments.

#### 35 U.S.C. § 103(a) Obviousness Requirements

35 U.S.C. § 103(a) states that a patent may not be obtained where the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. See 35 U.S.C. § 103(a), MPEP § 2141.

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. See MPEP § 2141.01(a). A reference is considered analogous prior art if the reference is either in the field of Applicants' endeavor or, if the reference is reasonably pertinent to the particular problem with which the Inventor was concerned. *Id.* A reference is pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. See *id.*, citing *Wang Laboratories v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993). Furthermore, when determining whether a reference is analogous, the Examiner cannot look at isolated teachings of the prior art without considering the over-all context within which those teachings are presented. *In re Pagliaro*, 657 F.2d 1219, 1225 (Cust & Pat.App., 1981). Thus, the Examiner must consider each reference as a whole and determine if the reference as a whole is concerned with problems associated with the pending application. *Id.*

The Examiner also bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness, the examiner must show that the prior art references, when combined, teach or suggest all the claim limitations. See MPEP § 2143.

#### Response to Examiner's Obviousness Arguments

##### *Analogous Art Requirement of 35 U.S.C. § 103(a)*

As stated above, to rely on a reference as a basis for rejection of Applicants' invention, the reference must be analogous prior art. Thus, the reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which Applicants were concerned. See MPEP § 2141.01(a).



The present application is directed to searching content in frames. See Application, *Field of the Invention*, Pg. 1, Para. 1. The present application addresses the problem of facilitating frame content searches within a multiple frames environment. See Application, *Description of the Related Art*, Pg. 1, Paras. 9-11. Thus, Applicants' field of endeavor is searching content in frames.

*Kumar* is directed to a mechanism for managing a plurality of profile data structures. See *Kumar*, *Abstract*. Thus, the field of endeavor in *Kumar*, as stated in *Kumar*, is managing profile data structures. *Id.* As described above, the field of endeavor of the present application is searching content in frames. Accordingly, *Kumar* is not in the same field of endeavor as the present application. Thus, for *Kumar* to be considered analogous art, *Kumar* must be reasonably pertinent to the particular problem with which the pending application was concerned, namely, facilitating frame content searches within a multiple frames environment.

As stated above, a reference is pertinent if, even though it may be in a different field from that of Applicants' endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Applicants respectfully submit that *Kumar* would not have commended itself to Applicants' attention in considering the problem of facilitating frame content searches within a multiple frames environment. Applicants submit that *Kumar* would not have commended itself to an inventor's attention because *Kumar* does not address the problem of facilitating frame content searches within a multiple frames environment, nor does *Kumar* at any point even mention frames. See generally, *Kumar*.

The sole section of *Kumar* cited by Examiner (Col. 15, lines 10-16) discusses specifying which version of a method will be used when a user makes a request to use a method. *Kumar*, Col. 15, lines 10-16. The section states that, by default, the most current version of the method may be used when a request is received. *Id.* The section does not refer to frames. *Id.* Further, as stated above, *Kumar* does not mention frames at any point. Thus, because *Kumar*, in both the cited section and when viewed as whole, does not mention frames, let alone searching frames or searching frame content in a multiple frame environment, *Kumar* does not commend itself to an inventor's

attention in considering the problem of facilitating frame content searches within a multiple frames environment.

Therefore, *Kumar* would not have commended itself to an inventor's attention in considering the problem of facilitating frame content searches within a multiple frames environment, and *Kumar* is thus not reasonably pertinent to the particular problem with which Applicants' were concerned. Accordingly, because *Kumar* is neither in the field of Applicants' endeavor nor reasonably pertinent to the particular problem with which Applicants' were concerned, *Kumar* is not analogous art and cannot be used as a prior art reference in a 35 U.S.C. § 103(a) obviousness rejection. Thus, Applicants respectfully submit that the obviousness rejection is improper and request that the rejection be withdrawn.

*All Limitations Requirement of 35 U.S.C. § 103(a)*

Even if *Kumar* were analogous prior art, Applicants respectfully submit that Examiner has failed to establish a *prima facie* case of obviousness. As stated above, to establish a *prima facie* case of obviousness, the Examiner must show that the prior art references when combined teach or suggest all the claim limitations. To establish a *prima facie* case of obviousness, the examiner must show that the prior art references, when combined, teach or suggest all the pending claim limitations. See MPEP § 2143. The pending claims describe designating one of at least two frames each containing searchable content as a default search frame. Examiner states that "*Kumar* discloses designating a default frame from a plurality of frames." Paper 10, Page 6, citing *Kumar* at Col. 15, Lines 10-16. Initially, Applicants note that the pending claims describe designating "a default search frame," (See, e.g., Claim 1), and not "a default frame" as Examiner states. Accordingly, per Examiner's own argument, all limitations of the pending claims have not been shown.

Further, even if it is Examiner's contention that the underlying passage describes designating a default search frame, Applicants respectfully note that the cited passage does not refer to either frames or searching. See *Kumar*, Col. 15, Lines 10-16. The cited section discusses methods implemented within core profile services. *Id.* The section states that as the core profile services of *Kumar* evolve, new versions of the

methods implemented therein may also evolve. *Id.* The section states that, by default, the most current version of the requested method may be used when a request is received. *Id.* Thus, the cited section of *Kumar* describes specifying which version of a method is used when a method request is made. *Id.* The cited section does not refer to designating a default search frame. Therefore, because neither *Kumar* nor *Hammack* teach, show, or suggest designating one of at least two frames as a default search frame, Examiner has not shown that the prior art references teach or suggest all of the pending claim limitations. Thus, the *prima facie* case of obviousness has not been established, and the obviousness rejection is improper. Accordingly, withdrawal of the rejection is respectfully requested.

In summary, Applicants respectfully submit that Examiner's obviousness rejection is improper for citing non-analogous art and for failing to establish a *prima facie* case of obviousness. Therefore, Applicants submit that claims 1-4, 6, 7, 10-13, 15, 18-21 and 26 are patentable over *Hammack* in view of *Kumar*. Withdrawal of the rejection is respectfully requested.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Hammack* and *Kumar* and further in view of *Tachibana et al.* (US Pat. No. 6,288,702, hereafter *Tachibana*). Applicants believe that the combination of *Hammack* and *Kumar* has been overcome for the reasons given above. Thus, Applicants respectfully submit that claim 5 is patentable over the combination of *Hammack* and *Kumar* and further in view of *Tachibana*. Withdrawal of the rejection is respectfully requested.

Claims 9, 17 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of *Hammack* and *Kumar* and further in view of *McKiel et al.* (US Pat. No. 5,388,993, hereafter *McKiel*). Again, Applicants believe that the combination of *Hammack* and *Kumar* has been overcome for the reasons given above. Therefore, Applicants submit that claims 9, 17 and 25 are patentable over the combination of *Hammack* and *Kumar* and further in view of *McKiel*. Withdrawal of the rejection is respectfully requested.

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of *Hammack* and *Kumar* in view of *Enns et al.* (US Pub. No.

PATENT  
Atty. Dkt. No. ROC920010074US1  
MPS Ref. No.: IBMK10074

2002/0065110, hereafter *Enns*). As stated above, Applicants believe that the combination of *Hammack* and *Kumar* has been overcome for the reasons given above. Therefore, Applicants respectfully submit that claim 14 is patentable over the combination of *Hammack* and *Kumar* in view of *Enns*. Withdrawal of the rejection is respectfully requested.

Claims 22 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of *Hammack* and *Kumar* in view of *Quinn et al.* (US Pub. No. 2003/0028850, hereafter *Quinn*). Once again, Applicants believe that the combination of *Hammack* and *Kumar* has been overcome for the reasons given above. Accordingly, Applicants submit that claims 22 and 23 are patentable over the combination of *Hammack* and *Kumar* in view of *Quinn*. Withdrawal of the rejection is respectfully requested.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Hammack* and *Kumar* and further in view of *Guthrie* (US Pub. No. 2002/0129064). Again, Applicants believe that the combination of *Hammack* and *Kumar* has been overcome for the reasons given above. Therefore, Applicants submit that claim 24 is patentable over the combination of *Hammack* and *Kumar* and further in view of *Guthrie*. Withdrawal of the rejection is respectfully requested.

#### REMARKS REGARDING EXAMINER'S RESPONSE TO ARGUMENTS

In Examiner's Non-Final Action, Examiner provides a *Response to Arguments* section regarding Applicants' arguments filed in the Appeal Brief of 8/13/2004. See Paper 10, Pg. 11. Examiner states that the Examiner is not persuaded by the arguments presented by the Appeal Brief. *Id.* The Examiner further states "that instant application does not contain patentable material" (see, e.g., Paper 10, Pg. 12) and that "Examiner finds it difficult to imagine how the designation of one of two text frames as a default frame can be considered patentable" (see Paper 10, Pg. 13). Given that the Examiner was not persuaded by the Applicants' Brief and given the Examiner's position that the invention is simply per se unpatentable, it is unclear why prosecution was reopened. Applicants desire to move prosecution forward and conclude proceedings with minimal expense. To the end, Applicants have made a good faith effort to submit a

Page 17

328664\_2

PATENT  
Atty. Dkt. No. ROC920010074US1  
MPS Ref. No.: IBMK10074

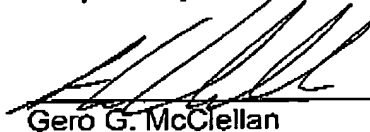
comprehensive response to the Examiner's issues. The Applicants have also made additional claim amendments in an effort to clarify the claimed embodiments. Given the Applicants strong believe that the rejections are improper, it should be clear that the amendments are being made only in effort to move prosecution forward in a meaningful way. In fact, Applicants submit the amendments merely make explicit what was already implicit in the clear meaning of a "default search frame". It is hoped that these amendments and the arguments herein will result in allowance of the claims. In the event the Examiner has some remaining questions or concerns that may prevent allowance, Examiner is strongly urged to call the attorney of record signing below.

### CONCLUSION

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Gero G. McClellan  
Registration No. 44,227  
MOSER, PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicant(s)